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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/540,026 Confirmation No. 8866
Applicant : Bertram SUGG
Filed : January 25, 2006
TC/A.U. : 2834
Examiner : B. Gordon

Docket No. : R.304045
Customer No. : 02119

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date: August 8, 2008

PETITION UNDER 37 CFR 1.144
REQUESTING WITHDRAWAL OF THE
RESTRICTION REQUIREMENT AS BETWEEN
CLAIMS 9-10 AND 13-14
VERSUS CLAIMS 29-32.

Sir:

In response to the Final Office action of January 9, 2008 and the advisory action of July 25, 2008, both of which incorrectly held that claims 29-32 are directed to an invention which is different from the apparatus which was elected on July 20, 2007, applicant requests that the examiner's decision to hold "election by prior presentation" and his attendant refusal to consider claims 29-32 in this application be rescinded, and that claims 29-32 be reinstated and examined in this application along with claims 9-10 and 13-14. It is applicant's position that both sets of claims are drawn to a piezoelectric actuator and should be examiner within the same application.

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HISTORY

On July 20, 2007 applicant elected the apparatus as exemplified by claims 9-16 in response to the Restriction Requirement of June 27, 2007. The first action on the merits, based on these claims, was mailed on August 8, 2007. As part of applicant's response to the first Office action claims 29-32 were added. Claims 29-32 are drawn to the same apparatus as was elected, however in the format of product-by-process claims. In the Final Rejection of January 9, 2008, the first action after these claims were added, the examiner held that the product-by-process claims 29-32 were for a different invention than the remaining apparatus claims 9-10 and 13-14. With this holding, the examiner then refused to consider them.

As part of the response to the Final Rejection, which response was filed on July 9, 2008, applicant argued that the examiner's holding of different inventions was improper. In the Advisory Action dated July 25, 2008 the examiner restated his reasons for insisting on restriction between the apparatus claims and the product-by-process claims.

This petition is filed in response to the Advisory action. In each and every response since this improper restriction was made, applicant has argued that the holding of restriction between these two sets of claims was not proper.

Again, it is applicant's contention that the examiner's action of holding that the apparatus claims 9-10 and 13-14 and the product-by-process claims 29-32 are restrictable constituted an improper restriction requirement. The product-by-process claims 29-32 are in fact apparatus claims. They are directed to a piezoelectric actuator, the same piezoelectric actuator as is recited in the elected apparatus claims 9-10 and 13-14.

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THE RESTRICTION WAS NOT PROPER

The action by the examiner of refusing to consider claims 29-32 constituted an improper restriction requirement in that these product-by-process claims are in fact directed to a piezoelectric actuator, which is basically the same piezoelectric actuator as recited in the elected apparatus, claims 9-10 and 13-14.

In the Final Office action of January 9, 2008, the examiner held that new claims 29-32 are directed to a non-elected invention, saying that they are for an invention which is independent or distinct from the invention recited in claims 9-10 and 13-14, reasoning that “The piezoelectric actuator can be made by another method such as compression of insulation material to the piezoelectric stack.”

The examiner’s action in this regard was incorrect. Claim 29 recites “**An apparatus** made by the following steps....”. Claims 30-32 each recite “**An apparatus** as recited in claim, wherein the steps also include....”. The steps recited in each of claims 29-32, and thus the product produced by the process, would be a piezoelectric actuator, the same apparatus as is recited in claims 9-10 and 13-14.

A search of the MPEP, particularly Chapter 800, has revealed no content regarding restriction between product-by-process claims and apparatus claims. Chapter 800 specifies and details the requirements for all instances of proper restriction, such as apparatus and the method for making it, i.e., claims 9-10 and 13-14 as opposed to non-elected claims 17-28, which is the examiner’s original restriction requirement. But chapter 800 of the MPEP has

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no content which describes the requirements for restriction between apparatus claims and product-by-process claims which are directed to the same apparatus. By not describing such a restriction and its requirement, the MPEP is effectively saying that such a restriction is not proper.

The product-by-process claims 29-32 are apparatus claims. If the examiner considers the situation properly, claims 29-32 are directed to the same apparatus as is recited in claims 9-10 and 13-14, a piezoelectric actuator. Claims 29-32 do recite the piezoelectric actuator to a different scope or breadth. However, it has long been held that differing scope or breadth is not an indicator of distinct inventions.

In the Final rejection the examiner made the comment that the piezoelectric actuator can be made by another method such as compression of insulation material to the piezo stack. The examiner's statement may be true, but it is of no significance with respect to the consideration of restriction between these claims. If the apparatus of the claims is to the same invention, differing only in scope or breadth, as it is in the present circumstances, restriction is not proper.

Moreover, MPEP 806.05 states in part, with emphasis added,

*A product defined by the process by which it can be made is still a product claim (*In re Bridgeford*, 357 F.2d 679, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention.*

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Thus, according to this paragraph, the product-by-process claims may be restrictable from process claims, such as non-elected claims 17-28. And the examiner's comment that the product could be made by a different process is indeed one of the possible reasons for requiring restriction between them, i.e., that claims 29-32 are restrictable from claims 17-28. But the MPEP does not give any support whatsoever for restricting between apparatus claims and product-by-process claims.

The examiner's statement that "the piezoelectric actuator can be made by another method such as compression of insulation material to the piezo stack" may have significance with regard to the application of prior art, but it is not determinative of the propriety of a restriction requirement.

In the instance of the claims presented in this application, the **structure** which would be produced by the process steps which are recited in claims 29-32 is clearly within the same invention as the **structure** which is recited in claims 9-10 and 13-14. The **structure** recited in both of these two sets of claims is a piezoelectric actuator, and thus the examiner's action of refusing to consider claims 29-32, or in other words holding restriction by prior presentation, was not proper. Claims 29-32 should have been examined along with claims 9-10 and 13-14 in the Office action dated January 9, 2008.

Both sets of claims recite a piezoelectric actuator, although with varying degrees of breadth. But varying breadth is not a valid reason for insisting on restriction when the claims recite the same invention, as do the claims of the present application.

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THE FINALITY OF THE LAST OFFICE ACTION SHOULD BE WITHDRAWN

Since the examiner's action of refusing to consider claims 29-32 was not proper, the **Finality** of the last Office action should now be withdrawn so that claims 29-32 can be examined along with claims 9-10 and 13-14, and the results of the examination included within a proper Office action.

SUMMARY

Claims 29-32 are product-by-process claims. In view of the nature of this invention, counsel believes that these claims recite the invention in a fashion which, although different in format from the way this same invention is recited in claims 9-10 and 13-14, is an appropriate alternative for reciting the invention which has been elected for this application. Claims 29-32 are directed towards the same invention as claims 9-10 and 13-14, and thus claims 29-32 should be reinstated into consideration and examined in this application along with claims 9-10 and 13-14.

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The Commissioner is authorized to charge payment of any appropriate petition fee, or any other necessary fees in connection with this communication, to Deposit Account Number 07-2100.

Respectfully submitted,

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